CERTIFICATE.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1910.

No. 101.

HILLS & COMPANY, LIMITED,

vs.

JOSEPH HOOVER ET AL.

ON CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

FILED NOVEMBER 17, 1906.

(21,417.)

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JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., JUNE 27, 1910.

1 In the United States Circuit Court of Appeals for the Third Circuit, October Term, 1907.

No. 15.

HILLS AND COMPANY, LIMITED, Plaintiff in Error,
vs.
JOSEPH HOOVER et al., Defendants in Error.

Writ of Error to the Circuit Court of the United States for the Eastern District of Pennsylvania.

Coram Dallas, Gray, and Buffington, JJ.

This cause comes before this court on a writ of error to the Circuit Court of the United States for the Eastern District of Pennsylvania. In that court Hills & Co., Limited, a corporation of Great Britain, brought an action of assumpsit for its own use and that of the United States against Joseph and Henry L. Hoover, citizens of Pennsylvania, and partners doing business as Joseph Hoover & Son, to recover, under R. S., Sec. 4965, an alleged money forfeiture of $4763, to the plaintiff, the copyright owner of certain engravings, being one dollar for each of forty-seven hundred and sixty-three copied sheets thereof found in the defendants' possession. In said suit a verdict for $4763, was rendered for the plaintiff, subject to the reserved question "whether there was any evidence to go to the jury in support of plaintiff's claim." Judgment was subsequently entered for the defendants on this reserved question whereupon the plaintiff sued out the present writ to this court.

2 The following stated facts are established. The plaintiff owned copyrights of certain engravings which the defendants wrongfully reproduced, sold some of the reproduced copies and on December 10, 1902 still had a number thereof remaining in their possession when the plaintiff's agent went to the defendants' printing establishment with a deputy marshal who was serving a writ of replevin the plaintiff had had issued in the Circuit Court against the defendants for infringing copies. The agent there found in the possession of the defendants forty-seven hundred and sixty-three infringing copies. These the Deputy Marshal then and there took and delivered to the plaintiff's agent who still retains them. Subsequently, on June 18, 1903, the plaintiff brought the present action of assumpsit against the defendants infringers to recover the one dollar forfeited to the plaintiff for each of the forty-seven hundred and sixty-three infringing sheets of the copyrighted engravings which on December 10, 1902 its agent had found in and taken from the defendants' possession. To this action the defendants appeared and pleaded non assumpsit and in it a verdict was had for the plaintiff as above noted. The action of replevin was no further proceeded in.

Such being the established facts and this court desiring the in-

structions of the Honorable, the Supreme Court of the United States, for the proper decision by this court of the subjoined question or proposition of law thereon arising, it is now ordered that the
3 following question of proposition of law, together with the foregoing statement of facts upon which it arises, be and the same is hereby certified to the said Supreme Court agreeably to the provisions of the sixth section of the Act entitled "An Act to establish Circuit Courts of Appeals, and to define and regulate in certain cases the jurisdiction of the courts of the United States and for other purposes" approved, March 3, 1891, to wit.

Under the above statement of facts, and the case involving no reversible error in other particulars, should judgment be entered for the plaintiff in error.

In testimony whereof the undersigned the Judges holding the said Circuit Court of Appeals have hereto set their hands and seals this sixth day of July 1908.

GEO. M. DALLAS, [SEAL.]
Circuit Judge.
GEO. GRAY. [SEAL.]
JOS. BUFFINGTON, [SEAL.]
Circuit Judge.

(Indorsed:) Hills & Co. Pl'ff in error, vs. Hoover et al., Def'ts in error. Certificate to the Supreme Court. Filed July 14, 1908.

4 United States Circuit Court of Appeals, Third Circuit, Oct. Term, 1907.

No. 15.

HILL & COMPANY, LTD., Plaintiff in Error,
v.
HOOVER et al.

And now October 6th, 1908 comes the plaintiff in error, by Hector T. Fenton of Counsel, and moves that the certificate to the Supreme Court of the United States, in the above entitled cause pending in this Court, be amended in the following particulars, namely by changing the form of the question certified, which is in the following words:—

"Under the above statement of facts, and the case involving no reversible error in other particulars, should judgment be entered for the plaintiff in error."

so that the same shall read as follows:—

"Under the above statement of facts, and the case involving no reversible error in other particulars:—

1. Whether, as a finding and seizure of piratical copies in the possession of an infringer, is essential to create a cause of action for the pecuniary penalty, and there being no single action known to the law of Pennsylvania which can be employed to find and seize infringing

copies and also to recover the pecuniary penalty provided by statute, the ruling in Werckmeister v. American Tobacco Co., 207
5 U. S. 375, to the effect that the statute contemplates a single action for the recovery of both is a binding rule of construction under such conditions in said State and applicable to the case at bar.

2. Whether, as replevin in Pennsylvania is a possessory action only, wherein recovery of the statutory pecuniary penalty, in addition to recovery of the infringing copies, is impossible, its employment in said State, under such conditions, as a legal process, not prosecuted to judgment, to effect a peaceable entry and seizure of offending copies found in the possession of an infringer, is inconsistent with a subsequent action of assumpsit to recover the pecuniary penalty for such copies so found and seized.

6 In the United States Circuit Court of Appeals for the Third Circuit, October Term, 1907.

No. 15.

HILLS & COMPANY, LIMITED, Plaintiffs in Error,
vs.
JOSEPH HOOVER et al., Defendants in Error.

Writ of Error to the Circuit Court of the United States for the Eastern District of Pennsylvania.

Coram Dallas, Gray, and Buffington, JJ.

Upon consideration of the Petition of the Plaintiff in Error for amendment of the Certificate to the Supreme Court of the United States in the above entitled cause pending in this Court, and of the argument on behalf of Defendants in Error in opposition thereto, it is now, October 13, 1908

Ordered that the Certificate to the Supreme Court of the United States, filed July 14, 1908, be and hereby is amended by omitting therefrom the following, to wit:

"Under the above Statement of Facts, and the case involving no reversible error in other particulars, should judgment be entered for the Plaintiff in Error?"

And by substituting for the above, the two questions following, viz:

1. In a Circuit Court of the United States within the State of Pennsylvania, is the owner of a copyright for engravings re-
7 stricted to a single action to find and seize the copies alleged to infringe, and likewise to recover the money penalty therefor?

2. In a Circuit Court of the United States within the State of Pennsylvania, does the institution by the owner of a copyright for engravings of an action of replevin for recovery of the copies al-

leged to infringe, not prosecuted to judgment, preclude such copyright owner from subsequently bringing and maintaining an action of assumpsit to recover the pecuniary penalty for the copies found and seized under the writ of replevin?

In testimony whereof the undersigned, the Judges of the said Circuit Court of Appeals have hereto set their hands and seals this 13th day of October, 1908.

GEO. M. DALLAS, [SEAL.]
GEO. GRAY, [SEAL.]
JOS. BUFFINGTON, [SEAL.]
Circuit Judges.

(Indorsed:) Amended Certificate of questions to the Supreme Court of the United States. Filed October 13, 1908.

8 UNITED STATES OF AMERICA,
Eastern District of Pennsylvania,
Third Judicial Circuit, set:

I, William H. Merrick, Clerk of the United States Circuit Court of Appeals, for the Third Circuit, do hereby certify that the foregoing certificate and statement of facts, and amended certificate in the case of Hills and Company, Limited, Plaintiff in Error, against Joseph Hoover and Henry L. Hoover, co-partners doing business as Joseph Hoover & Son, Defendant in Error, was duly filed and entered of record in my office by order of said court, and, as directed by said court the said certificate is by me forwarded to the Supreme Court of the United States for its action thereon.

In Testimony Whereof, I have hereunto subscribed my name and affixed the seal of the said Court at Philadelphia, this tenth day of November in the year of our Lord one thousand nine hundred and eight and of the Independence of the United States the one hundred and thirty-third.

[Seal United States Circuit Court of Appeals, Third Circuit.]

WM. H. MERRICK,
Clerk U. S. Circuit Court of Appeals, Third Circuit.

Endorsed on cover: File No. 21,417. U. S. Circuit Court of Appeals, 3d Circuit. Term No. 101. Hills & Company, Limited, vs. Joseph Hoover et al. (Certificate.) Filed November 17th, 1908. File No. 21,417.

Office Supreme Court, U. S.
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JAMES H. McKENNEY,
Clerk.

IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1910.

No. 101.

HILLS & COMPANY, Limited,

v.

JOSEPH HOOVER, et al.

On Certificate From the United States Circuit Court of Appeals for the Third Circuit.

BRIEF FOR HILLS & CO., Ltd.

BENNO LOEWY,
HECTOR T. FENTON,
Counsel for Hills & Co., Ltd.

International, 258 Chestnut St.

Supreme Court of the United States.

October Term, 1910. No. 101.

HILLS & COMPANY, LIMITED,

v.

JOSEPH HOOVER, ET AL.

ON CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

BRIEF FOR HILLS & CO.

This case comes before this Court upon a certificate from the Circuit Court of Appeals for the 3rd Circuit, under the 6th Section of the Judiciary Act of March 3, 1891 (26 Stat. 826, C. 517) which provides that in every case within its appellate jurisdiction a Circuit Court of Appeals may certify to this Court any question or proposition of law concerning which it desires instruction for the proper decision of such case.

The certificate contains a preliminary statement that the cause is pending before that Court on a writ of error to the Circuit Court of the United States for the Eastern District of Pennsylvania, brought by Hills & Co., plaintiffs in error and plaintiffs below, to reverse a judgment entered by the trial Court in favor of Joseph Hoover, *et al.*, defendants in error and de-

fendants below, in an action of assumpsit to recover a pecuniary penalty of $4,763.00 for violation of plaintiff's copyrights on certain engravings, pursuant to the statute R. S. sec. 4965; said amount claimed being the aggregate of $1. per copy for 4763 infringing copies previously found in possession of defendant and seized immediately prior to the institution of the action of assumpsit aforesaid.

It is not inapropos to note that the validity of the copyrights involved in this case, have been adjudicated in Hills *v.* Austrich, 120 Fed. 862 (2nd Circuit), and Hills *v.* Hoover, 136 Fed. 701 (3rd Circuit) in equity proceedings to enjoin further infringement; in which latter case, the Court took occasion to say of the defendants' acts, that the infringement was willful and done with notice of the copyright.

STATEMENT OF FACTS.

The certificate contains also a statement of the facts established in the record before it, on which arise the two questions of law certified. Without quoting the statement in full, these established facts are, in substance (1) that plaintiffs owned copyrights of certain engravings; (2) that defendants infringed the copyright by wrongfully reproducing said engravings, and on December 10, 1902, had a quantity of them on hand in their printing establishment; (3) that on said date plaintiff's agent went to defendant's printing establishment with a deputy U. S. Marshal who was serving a writ of replevin the plaintiff had issued out of the Circuit Court against defendant for infringing copies, and then and there found in the possession of defendant 4763 infringing copies; and these the officer then and there seized and delivered to plaintiff's agent, who still retains them; (4) that having so effected the finding and seizure; thereupon,

on June 18, 1903, plaintiff brought the present action of assumpsit against said defendant to recover the *pecuniary* penalty provided by the same statute—(R. S. Sec. 4965)—which authorized the seizure of the offending copies; (5) that said action of assumpsit, after issue joined and trial had thereon, resulted in a verdict for plaintiff for the sum of $4763.00; whereupon the trial Court on motion for judgment *non obstante veredicto,* entered judgment for defendant, and plaintiff thereupon sued out a writ of error to the Circuit Court of Appeals; (6) that the action of replevin, first begun as aforesaid, was not proceeded with beyond the issue of the writ and the service thereof, as stated.

This statement may properly be supplemented by the following explanatory statement. The aforesaid action of assumpsit brought by Hills & Co., in the Circuit Court was in the form commonly used in Pennsylvania to recover money demands, including pecuniary penalties imposed by statutes; the narr or statement filed reciting the copyright ownership, the infringement thereof, and the previous finding of 4763 infringing copies in the possession of defendant, and their seizure; and thereupon averring that a cause of action accrued thereon to the plaintiff to recover $4763.00, the same being the pecuniary penalty of $1. per sheet or copy imposed by the copyright statute then in force, one-half to the use of the United States.

The aforesaid writ of replevin under which the finding and seizure of the offending copies, were peaceably made, (for the statute operated *in rem* to forfeit them to the plaintiff, when so found in the possession of the offender) was the form of writ commonly employed for a century past in Pennsylvania, to seize the goods and summon the defendant, in an action of replevin as required by the Statute and practice in Pennsylvania, begun by the plaintiff in the same court in

which the action of assumpsit was afterwards instituted.

The proposition is indisputable that there is no form of *single action* or proceeding, known to the law in Pennsylvania, or permitted by its statutes and recognized legal procedure, by or under which the two distinct forfeitures—the infringing copies and the money penalty—provided by the copyright statute—could be effected; and equally indisputable that the action of replevin, in Pennsylvania, is incapable of being employed to enforce the *pecuniary* forfeiture which resulted from such finding and seizure; or of being moulded or extended to accomplish that result. And it is equally indisputable that under the decisions of this Court in Thornton *v.* Schreiber, 124 U. S. 612, and Bolles *v.* Outing Co., 175 U. S. 262, the actual finding of infringing copies *in the possession of defendant*, and their seizure as well (in enforcement of the first forfeiture imposed by the statute) was absolutely essential *prior* to institution of any action or proceeding to enforce the *pecuniary* penalty, or even to create a cause of action therefor.

The single purpose of the institution of the action of replevin, (effected by the issuance, and followed by the service of the said writ), having been accomplished,—to wit: the finding of the infringing copies in the actual possession of defendant and the seizure and delivery thereof to plaintiff or its agent, no further proceedings were had therein, by way of trial, verdict or judgment, as such proceedings could only have confirmed the legality of the seizure already accomplished, *and nothing more.*

The cause of action for the pecuniary penalty—*i. e.*, the additional and independent forfeiture provided by the copyright statute—having thus accrued or been effected, this action of assumpsit, as a *qui tam* action, to enforce the money forfeiture and recover it, was

instituted, and after being put at issue was tried before a jury, but the verdict rendered for the plaintiff for the amount claimed was set aside by the trial Court by entry of judgment *non obstante*, for defendant, no opinion being filed. A writ of error was then sued out by the plaintiffs, Hills & Co., and the cause argued in the Court of Appeals, on the record sent up. It singularly happened that a day or two before the argument, this Court pronounced its decision in Werckmeister *v.* American Tobacco Co., 207 U. S. 375, wherein it seemed to be suggested that all the remedies given by the copyright statute, for infringement, must be enforced in a single action or single judgment; and in consequence of a doubt created thereby, the U. S. Court of Appeals for the 3rd Circuit postponed its judgment on the writ of error referred to, and certified to this Court the two questions of law stated in the certificate.

These are as follows:

1. In a Circuit Court of the United States within the State of Pennsylvania, is the owner of a copyright for engravings restricted to a single action to find and seize the copies alleged to infringe, and likewise to recover the money penalty therefor?

2. In a Circuit Court of the United States within the State of Pennsylvania, does the institution by the owner of a copyright for engravings, of an action of replevin for recovery of the copies alleged to infringe, not prosecuted to judgment, preclude such copyright owner from subsequently bringing and maintaining an action of assumpsit to recover the pecuniary penalty for the copies found and seized under the writ of replevin.

These two questions, it will be observed, are of different scope, and are capable of being answered, the first in the affirmative (though not necessarily so, nor without qualification), and the second in the negative, without defeating the plaintiff's pending action and its right of recovery therein of the pecuniary forfeit sued for. In other words the language of this Court in Werckmeister *v.* American Tobacco Co., *supra*, is not, as we read it, broadly and without qualification, that both forfeitures provided by the copyright statute in question, must be enforced, "in a single suit"; but rather, as a qualification, that the statute discloses no "intention of Congress to permit a recovery of the money penalty only after *judgment of forfeiture* (of the infringing copies found and seized in possession of defendant) had gone in favor of plaintiff." There is a broad distinction between a "writ" and a "suit" or "action"; and this distinction is well pointed out, in proceedings under the New York Code, (and this Werckmeister case was governed thereby, as it came from the Southern District of New York) in an opinion by Judge Ward in Stern *v.* Remick, 164 Fed. Rep. 781, (a case in the Circuit Court for the Southern District of New York) on motion to vacate writ of seizure, in proceedings under this same copyright statute, R. S. 4965, wherein the learned Judge showed by reference to New York Code, Secs. 416 and 1693 and State Court decisions construing them, that the writ of seizure was to be treated as a preliminary and provisional writ or remedy under the Code and the writ of summons an independent and subsequent process, in the same action; and also that the "action" is only "commenced when the *summons* is served", because, in the State of New York, the Code of Civil Procedure, Sec. 416 so declares.

But no such "action" nor series of procedure is

known to or permissible under the law and practice in Pennsylvania. As it was therefore quite possible, under the New York Code, for the plaintiff, in Werckmeister *v.* Tobacco Co., *supra*, to have pursued his two remedies—*i. e.*, effected the two distinct forfeitures, of infringing copies and money penalty—in the single action under consideration by this Court, on the writ of error in that case, the decision of this Court, we think means and was based upon a finding in the nature of a "former recovery", on the ground that the Circuit Court was without power to award the *second judgment* in the separate action for the money penalty (last par. p. 384 of opinion) because "the plaintiff in error had exhausted his remedy in the *judgment* rendered in the first suit", which was a replevin action, prosecuted to judgment, the record of which "with the pleadings and judgment" he offered in evidence in the second suit, to maintain the affirmative of the issue therein. The case went off on that ground; (C. C. 138 Fed. 162, and C. C. A. 148 Fed. 1022), and was properly affirmed by this Court for that reason if for no other; for it is indisputable that a judgment is conclusive as to every right which was or might or should properly have been claimed in the action in which such judgment is entered.

A Brief Review of the Origin and Evolution of Copyright Statute R. S. 4965.

The statute on which the action is founded, and the construction of which is incidentally involved in answering the two questions at law certified to this Court, is Rev Stat. 4965, originally enacted as part of a system of copyright law by Act of July 8, 1870, and amended by Act of March 2, 1895. As so amended it reads as follows:

> "Sec. 4965: If any person, after the recording of the title of any map, chart, dramatic or

musical composition, print, cut, engraving or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts, as provided by this Act, shall, within the term limited, contrary to the provisions of this Act, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, engrave, etch, work, copy, print, publish, dramatize, translate, or import, either in whole or in part, or by varying the main design, with intent to evade the law, or, knowing the same to be so printed, published, dramatized, translated, or imported, shall sell or expose to sale any copy of such map, or other article, as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied, and every sheet therof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale;

* * * * * * * * *

"Provided, further, That in case of any such infringement of the copyright of a painting, drawing, statue, engraving, etching, print, or model or design for a work of the fine arts or of a photograph of a work of the fine arts, the sum to be recovered in any action brought through the provisions of this section shall be not less than two hunded and fifty dollars, and not more than ten thousand dollars.

"One-half of all the foregoing penalties shall go to the proprietors of the copyright and the other half to the use of the United States."

Without considering the entire body of copyright law, enacted from time to time, in England and in this country, it is sufficient to say that in the American Act of April 29, 1802, preceding that of Rev. Stat. 4965 (first enacted July 8, 1870), the penalty for infringement was a double forfeiture, first of the infringing

copies and next of a pecuniary penalty measured by the number "found in his custody"; but the infringing copies were to be "forthwith destroyed." This was also true of the earlier and repealed British Statutes, 8 Geo. 2, ch. 13, sec. 1, enacted in 1734 and of 5 and 6 Victoria, ch. 45, sec. 14, enacted in 1842, which provided for a forfeiture of infringing copies and also directed their destruction, as also of a pecuniary penalty, half to the Crown and the other half to the copyright proprietor.

But we are more interested in the *remedy* to enforce the forfeitures, rather than in the forfeits; and considerable light thereon, by analogy to the other part of British Statute 5 and 6 Victoria, ch. 45, sec. 23, will be had. It reads as follows:

> "XXIII. And be it enacted, That all copies of "any book wherein there shall be copyright, and of "which entry shall have been made in the said reg- "istry book, and which shall have been unlawfully "printed or imported without the consent of the "registered proprietor of such copyright, in writing "under his hand first obtained, *shall be deemed to "be the property of the proprietor of such copy- "right*, and who shall be registered as such, and "such registered proprietor shall, after demand "thereof in writing, be entitled *to sue for* and re- "cover the *same*, or damages for the detention "thereof, in an *action* of *detinue*, from any party "who shall detain the same, or to sue for and "recover damages for the *conversion* thereof in an "action of *trover*."

Comparison of the Action of Replevin and Detinue, as the Latter was Formerly Known in England and in Pennsylvania.

The former action has been somewhat modified and the latter some years since abolished entirely, by statutes in Pennsylvania. We refer briefly to the latter herein, for the single purpose of showing that in England the remedy by *action of detinue*, as directed by the Statute 5 and 6 Vict. ch. 45, sec. 23, *supra*, was a substitute and full equivalent for replevin, under the forfeiture (of copies) clause of that copyright statute. The action of *detinue* and its characteristics are defined in Troubat & Haly (Practice in Pennsylvania) Vol. 2, sec. 1538, *et seq.*, as follows: This action was the only remedy by suit for the recovery of a personal chattel, except in those cases where the party was able to seize and regain the possession by replevin. * * * In *detinue* the plaintiff sought to recover the goods in specie, or in the *alternative*, the value (for the defendant had an election, in such case, whether he deliver the goods or pay the value thereof) and also damages for the detention. * * * The gist of the action in both cases was the wrongful detainer and not the original taking; the mode by which defendant obtained possession of the chattel, whether tortiously, or by a delivery or finding, being immaterial. * * * The ancient form of the *Writ in Detinue* was changed by Penna. Statute of June 13, 1836 to that of a mere personal summons to appear and answer, and since then entirely abolished.

Manifestly, the American copyright statutes were suggested by, if not copied in the main from, the English statutes. If, therefore, we critically examine the English statute last above quoted, we have a flood of light on the meaning of the word "forfeit" in respect of the infringing copies; because, as remarked by the author of Drone on Copyright (page 469), the English

law, in respect of the penalty, was amended (by the 5 and 6 Vict., ch. 45, sec. 23) in 1842 to change the forfeitures from a mere punishment of the offender to a direct benefit to the owner of the copyright (subject to a moiety of the pecuniary penalty accruing to the Crown, in England, or to the Federal Government, in our own country), for it provided, as he correctly says, that "the piratical copies are *declared* to "be *the property* of the author, who is empowered "to recover them, or damages for their detention."

Thus we have support for the view that the word "forfeit" is not used in its ordinary sense, as when used in collocation with "condemnation," because the words "the property" imply a *divestiture of title*, and the words "damages for detention" as clearly imply the same thing, since there could be *"damages for their detention" only on the theory that the sheets were the* PROPERTY *of the author.*

It is further instructive to observe from the reports of Parliamentary proceedings on the proposed bill introduced in 1883 to amend the copyright laws, Sec. 17 of that proposed act provided in case of piracy that "all copies and the plates from which such copies are taken shall be *the property* of the owner of the copyright, and may be recovered by him."

We are much embarrassed in not finding, after diligent search, any reported cases in England, bearing directly on the point under consideration, save Delf *v.* Delamotte, 3 Jurist Rep., N. S., Part 1, p. 933, which was an action founded on sec. 23 of 5 and 6 Vict., ch. 45, wherein Wood, V. C., remarked, as *obiter* only, "it "may be true that it has been intended to introduce "as great an alteration in respect of the proceeds "of the copies which have been sold as *in the right "of property in the copies which have not been sold*, "and which by the present law *are declared to be the "property of the true proprietor of the copyright and*

"*are handed over to him accordingly,* whereas under "the former law they were always destroyed."

In the light of this prior British statute of 5 and 6 Victoria, after which our own was presumably modelled; of the interpretation thereof by a learned text writer, and by Vice Chancellor Wood, in the case cited, *supra,* let us look again at our own statute.

Much of the conflict, whether apparent or real, in the earlier decisions, construing the copyright statute Rev. Stat, sec. 4965, has probably arisen from a misinterpretation of the word "forfeit" in the statute, in respect of the infringing copies. The Circuit Court (Pennsylvania) said in Falk *v.* Curtis, 102 Fed. 967, affirmed 107 Fed. 126, that the statute seems "to mean that before the action for the penalty would lie there must be a finding of the articles in the possession of the defendant by means of a proceeding instituted for the *express purpose of condemnation and forfeiture,* and that an action of assumpsit brought at the same time with the action of replevin was premature; while the Court of Appeals in Bolles *v.* Outing Co., 77 Fed. 966, affirmed 175 U. S. 262; the former said that the words, in the statute, "found in his possession" are to be construed to "aptly refer to a finding for the purposes of *forfeiture and condemnation.*"

But our statute *does not contain the word "condemnation,"* and if the single and simple word "forfeit," therein, has the same meaning which it has in the British statute before referred to, wherein its meaning is defined in unmistakable terms, then the above quoted remarks from Falk *v.* Curtis and Bolles *v.* Outing Co. were not justified and were a misinterpretation of the statute.

The word "forfeiture" when used in collocation with "condemnation," is synonymous with "confiscation;" but used separately it is well known that "forfeiture" and "confiscation" have distinctly different meanings; the former is generic relatively to the spe-

cific meaning of the latter. As defined by Blackstone, in reference to lands (8 Comm. 267), "forfeiture" means simply a *divestiture of title,* not a confiscation. The lay meaning, as given in the Century Dictionary, Vol. 3, page 2331, is "Title by Forfeiture. Specifically in law the divesting of property, or the termination or failure of a right, by or in consequence of a wrong, default, or breach of condition."

We have conclusive support for that view of the British statute, because the words "the property" imply not a mere confiscation but a *divestiture of title,* and the further words that the "registered proprietor" shall "be entitled to sue for and recover the same (the infringing copies) or damages for the detention thereof, in an action of *detinue,*" etc., as clearly imply the same thing, since *detinue* as then known in England was a possessory action primarily, though providing an alternative remedy, and the words "damages for their detention" can only imply that the infringing copies became, by the very act of infringement, the *property* of the copyright proprietor, otherwise they would be inconsistent with the "forfeiture" created by the statute.

Now, our own statute, R. S. 4965, was originally enacted in 1870, *after* the aforesaid British statute of 5 and 6 Vict., and that it was presumably modelled after it, is a fair inference. So considering it, the word "proprietor," used both in the British and the American statutes, has a significance which is not alone that of owner of a mere monopoly to multiply or reproduce, which is an intangible right; but is of much broader significance and includes an ownership of the mental conception, attaching to every exemplification of it, whether made by himself, or by any person without his authority, the statute so declaring and operating on the *title* to the latter. Hence we can readily understand that a possessory action, such as replevin, could

be properly employed in England, at that time, to enforce the *delivery,* or *detinue* or *trover,* the former to recover "damages for their detention" and the latter for damages for the "conversion."

(True, the action of *detinue* has long ago fallen into disuse in Pennsylvania, but even when used there were very few instances where replevin would not have been a permissible substitute. It is equally true that *trover,* as a form of action, has been abolished in Pennsylvania by the Procedure Act of May 25, 1887, but under that act the action of trespass was expressly enlarged in scope to include all recoveries which might have been had in the action of *trover, and by it the action of replevin was expressly preserved.*)

Unlike the British statute, our own Rev. Stat. sec. 4965, wholly omits to express in words the clear intent that the statute shall operate directly on the title to and right to possession of the piratical copies, and wholly omits to define the remedy for enforcement of such right of property which it creates, *or perhaps more correctly which it recognizes to exist in the real owner.*

As to the first omission, it may be correctly said that as *the clear intent* of the statute was to operate on the *title* to the piratical copies, it was unnecessary to say (as the English statute does) that they "shall be deemed to be the *property* of the "proprietor of such copyright." As to the second omission, it is sufficient to say that the reason for it is obvious; the remedy was clearly an action at law, and the form and procedure varies in the different States, which (under other acts) controlled the procedure in the Federal Courts in actions at law. Aside from that, however, it is well settled where a statute gives a right, without defining a remedy, the common law remedies may be resorted to to enforce such right. Sedgwick on Construction of Statutes, 75; Dwarris on Stat., 185, or Maxwell on Interp. of Stat., 368.

If in this partial and brief review of the origin and evolution of our own Stat. R. S. 4965, we note the striking similarity to that of 5 & 6 Vict., in respect (1) of a forfeit of the infringing copies to the "proprietor" of the copyright; (2) the absence of the expression "forfeiture and condemnation", but the use of the word "forfeit" alone, implying a divestiture of *title* in the infringer and a right of property, by operation of law, in the copyright proprietor, we will have no difficulty in applying appropriate remedies, because we will see that the true meaning of the word "forfeit" is the same in our Statute as in the British.

The meaning of that word, in the copyright statute in question, is well, and, we think, correctly stated by Judge Seaman in Morrison *v.* Pettibone, 87 Fed. 330, in which he said:

> "The term 'forfeit' as used in the statute is not to be taken in its strict, ordinary sense; the Act of Congress clearly intending to give to the proprietor an exclusive right of property in that which has been produced by his mind and skill, confers as well *an ownership* in all copies which are made by infringers; and that through the act of piracy *the title* to the imitation *vests* in the proprietor of the copyright, *in that sense only being forfeited*, and, so regarded, replevin would lie to obtain possession."

And so regarded, replevin, in Pennsylvania, would lie to obtain possession.

If this view, so expressed by Judge Seaman, as to the meaning of "forfeit", in our statute, was an inspiration, it was a true one, and accords fully with the declared meaning of the British statute, expressed on its face, and as interpreted in Drone on Copyright, *supra.*

Replevin in Pennsylvania.

The character and limitations of the action of replevin and the writ issuable therein, as authorized by law and procedure in Pennsylvania, next requires our attention. Its origin and antiquity in England is stated with interesting clearness by Glanville (Beames Glanv. 294) and in Morris on Replevin, an English work exhibiting great learning and research. Its form as also its original purpose, functions and limitations have been preserved almost intact in Pennsylvania. Troubat *v.* Haly's Practice, Vol. 2, p. 153, *et seq.* In that State, as formerly in England, it is primarily a proceeding *in rem.*, and incidentally a personal proceeding only in that it contains a cause of summons to the defendant. If the goods be seized under the writ, and the plaintiff put in possession of them as commanded thereby, the subsequent pleading is in the *detinuit;* but if the officer be prevented from, or otherwise unable to seize the goods, the pleading is in the *detinet* for the recovery of their value. It is the latter exigency only which qualifies it as a proceeding purely *in rem.*

With these general remarks it will be sufficient for the purpose of this inquiry, to quote from one or more decisions of Judges Dallas and McPherson in the U. S. Circuit Court for the Eastern District of Pennsylvania, in which it was attempted to use the action and writ of replevin, under this Copyright Statute R. S. 4965, to enforce the forfeiture of both the infringing copies and the pecuniary penalty, in the same action. As pointed out by the learned Judge, the character and limitations of the action of replevin, in Pennsylvania, were such as to preclude its use for any such double purpose, and certainly not for the second purpose even if capable of such use for the first purpose, *i. e.*, to enforce the forfeiture of the infringing copies by effecting their seizure.

In Falk *v.* Curtis Publishing Co., 100 Fed. 77 (81) Judge Dallas said, construing the Copyright Statute R. S., sec. 4965, on demurrer to the narr or statement:

> "It is, of course, true that this section (4965) being penal, ought, if ambiguous, to be construed with such strictness as to carefully safeguard the rights of the defendant. But it is not ambiguous. The meaning of its language is too plain to admit of cavil or doubt. (Quoting it.) It will be observed that, at the outset, several acts are enumerated, the commission of *either* of which is made a cause of forfeiture. This is the clearly expressed design of the first part of the section. There the *causes* of forfeiture are fully and finally stated, and the remainder of the section is directed solely to designating what shall be forfeited. It prescribes that 'every sheet thereof', without qualification or exception, must, because of the commission of any of the previously enumerated infringing acts, be yielded up by the infringer; and that, for the same reason, he shall *further* forfeit on dollar for every sheet of the same *found in his possession.*" (Italics ours.)

Later, in the same case, after trial on the pleadings, Judge McPherson said: 102 Fed. 967 (969, *et seq.*)

> "It is therefore clear that no penalty is recoverable except for such sheets of the infringing publication as may have been found in defendant's possession for the purpose of forfeiture and condemnation. * * * What, then, is the appropriate course of proceeding for the purpose of enforcing the forfeiture alone, or for collecting the penalty alone, or for the double purpose of enforcing the forfeiture and also of collecting the penalty? * * * In Thornton *v.* Schreiber, (124 U. S. 612) Mr. Justice Miller had apparently two *successive* suits in mind,—one an action to forfeit, whereby the infringing articles may be found in the possession of the defendant, and a *subsequent* suit for the penalty; the cause of action to be enforced in the

second suit only arising when the articles are thus found. This is the only meaning that I can derive from the declaration (in Thornton *v.* Schreiber, *supra*) that 'there must be a time before the cause of action (for the money penalty) accrued, at which (the infringing articles) are found in the possession of the defendant.'

"* * * On the other hand, in Bolles *v.* Outing Co., (175 U. S. 262), Mr. Justice Brown intimates that a single suit may be used for both purposes; but he does not mean the ordinary action of replevin, for he is careful to refer to the proceeding as a suit 'in the nature of replevin' * * * 'It seems to me to be clear that the action of replevin as it is now known to the profession, cannot be used for either purpose or *for both* without laying violent hands upon it. As it is now used, at least in the Courts of Pennsylvania, to which I shall confine my attention, the claim-property bond is an essential part of the proceeding * * * the right of the defendant to give a claim-property bond, and thus retain the property, with an indefeasible title thereto, must be wholly disregarded before the right to forfeit can be enforced."

The learned Judge was quite right that, in replevin, as known in Pennsylvania, the action cannot be used to enforce *both* forfeitures; and this because of its limitations as we have pointed out; but we think, also, that the Statute 4965 operates to divest the defendant's *title;* in other words that "forfeit" does not mean "forfeiture and condemnation" implying a *judgment of condemnation* to enforce the forfeiture.

If, as Judge Seaman interpreted the statute, and as it is defined in the British Statute, the very act of infringement operated to cause the infringing articles to become the "property" of the plaintiff, then of course the common law writ of replevin would lie to recover their possession. It is no answer to suggest that defendant might enter a claim property bond; the entry of such a bond cannot overcome the fact of the actual

finding and seizure under the writ. Such bond is a mere substitute for the goods. It is merely an optional right which the defendant has, and if he chooses to exercise it, it neither makes the initial action and writ inapplicable to the situation or cause of action nor qualifies or changes the *effect of the officer's act previously done under the writ, i. e.*, the finding and seizure. They are, as the French would express it "un fait accompli." And when so accomplished the "finding and seizure in the possession of defendant", of the infringing articles, is complete and the cause of action for the recovery of the other forfeiture—the pecuniary penalty—has thereby arisen or accrued.

This Court said in Bobbs *v.* Merrill, 210 U. S. 339; *subsequent* to its decision in Werckmeister *v.* Tobacco Co., *supra*, construing the Copyright Statutes, that "they are to be reasonably construed. They are not to be extended, by construction, to include privileges and intended to be conferred, *nor so narrowed as to exclude benefits which Congress did intend to confer.*"

Can it therefore be that in the State of Pennsylvania, in which there is no form of action in which these double remedies can be enforced, one of "those benefits which Congress intended (by the copyright statute) to confer" is to be denied to an author or proprietor for that reason and that only? We cannot believe that this Court so intended by the language of the opinion in the Werckmeister case, 207 U. S. 375, to the effect that "a single action" only is permissible; but rather that such should be its strict meaning in any State wherein all the remedies given to the copyright proprietor *can* be so enforced.

Comparative Analysis of the Opinions in Bolles *v.* Outing Co., 77 Fed. 966 and 175 U. S. 262, and in Werckmeister *v.* American Tobacco Co., 207 U. S. 375.

We may premise this comparative analysis with the remark that neither of these decisions qualify the previous ruling of this Court in Thornton *v.* Schreiber, 134 U. S. 612, holding that the cause of action for the pecuniary penalty under Rev. Stat. 4965 arose only on a finding and seizure of infringing copies in the actual possession of the defendant, and that the amount of the money penalty recoverable was limited to the number of copies so found and seized. Starting out with that proposition as a certainty, coupled with the obvious fact apparent on the face of the statute that, for infringement of the copyright, it operated to forfeit to the proprietor not only all infringing copies but a pecuniary penalty based thereon, the single question is what is or may be an appropriate legal method or procedure to secure to the injured copyright proprietor the benefits and remedies which the statute distinctly confers. Without citing statutes and decisions, it is sufficient to say that it is well settled that in actions at law in the Federal Courts the practice and procedure is such as that which prevails in the State in which the Court is held. Hence we contend as a broad proposition that if in a State, for example New York, its practice and procedure under its code is such that both these remedies could have been enforced in a single action, such as "the ordinary action of replevin under the New York Code", then the decision in Bolles *v.* Outing Co., 77 Fed. 966 (a case arising in New York) affirmed 175 U. S. 206, that R. S. 4965 "contemplates two remedies, enforceable in a single suit", was fully justified, as applicable to cases arising in that jurisdiction; but not applicable in a State, for example Pennsylvania, wherein its State practice and

procedure is such as to make it impossible to enforce these two remedies in a single action. And this is especially true where the Federal Statute, R. S. 4965, provides no form of action or procedure to recover the benefits given by it.

It must not be overlooked that in the Werckmeister case, 175 U. S. 375, there was not only a seizure in the replevin proceedings but a *judgment* of condemnation. Hence when the second action was brought, thereafter, to recover the money penalty, the defendant contended on the trial and repeated his contention here (see p. 378 of 175 U. S.) that "a second and separate action will not lie for penalties, after a *judgment* in a former distinct action for forfeiture of sheets." In sustaining that contention this Court said, p. 383:

> "There is nothing in this section which seems to contemplate the method of procedure pursued in this case, namely a separate action for the money penalty, upon the theory that it arose only in case of actual finding *and judgment of condemnation*, but the statute contemplates the bringing of the offender into Court in one suit, on which the plates and sheets shall be seized and forfeited and the penalty recovered." (Italics ours.)

Again on page 384, this Court said:

> "Had it been the intention of Congress to permit a recovery for the money penalty only *after judgment of forfeiture* had gone in favor of plaintiff, &c. (Italics ours.)

If the thought in the mind of this Court, in the rulings above quoted, was as we suggest by above italicised words, that a final *judgment* in the first case was conclusive as to all questions and rights which were open to be adjudicated therein (including a claim for the money penalty, which the plaintiff could have claimed but did *not* claim therein), and hence the plaintiff had voluntarily exhausted his remedy, we have no criticism to make of it; but a mere action be-

gun by writ, and not proceeded with is a very different thing from a judgment in such action. We will consider this aspect of the matter, later in this brief, in a discussion of the 2nd question certified. At present we will confine ourselves to suggestions which we think pertinent in reaching a correct answer to the first question certified.

Distinction Between Cumulative and Inconsistent Remedies.

It is manifest that the decision in the Werckmeister case went off on an application of the doctrine of election of remedies, wherein either or both of the forfeitures in favor of the plaintiff could have been availed of and effected; hence as, under the New York Code, both could have been adjudicated in the first action, in which there was *judgment* claimed and obtained for one only of these benefits, the plaintiff was properly held to have made his election, and was necessarily debarred from maintaining a second action for the other benefit which he could have claimed in the first action.

But in the case at bar there was nothing inconsistent in the initiation of two successive actions (especially if the first was not brought to issue or trial) if the exigencies of the locus of the forum, in respect of the forms of legal procedure prevailing therein, as affecting the two interrelated remedies sought to be enforced, require it, and this is particularly so where, as here, this Court has repeatedly held—notably in Thornton *v.* Schreiber, 124 U. S. 612, a case which was decided in 1888 and has been regarded and followed for over twenty-two years as an authoritative declaration of this Court of the fundamental principle that to authorize or justify a *qui tam* action or proceeding for the pecuniary penalty there must have been a

'previous finding'', in defendant's possession, of the infringing copies, and their seizure; clear implication from which is of a requirement for the institution of some action or writ or legal method by which a lawful entry into defendant's premises could be had and the finding and seizure effected. And that ruling was followed and applied in Pennsylvania, by the Circuit Court of Appeals in Falk *v.* Curtis Publishing Co., 107 Fed. Rep. 126, as follows:

> "In the case at hand there was no seizure by "condemnation, forfeiture, or otherwise before the "bringing of the present suit, no prints had been "found in the defendant's possession when the "summons in assumpsit issued, and consequently "the defendant had not then 'forfeit(ed) one dol- "lar for every sheet found in his possession'. If "there was no forfeit when the action began, it "follows there was no existing right of action to "recover the fruit of the forfeiture; for an action "is the prosecution of an existing right. There "must be finding before there is forfeiture; there "must be forfeiture before the right accrues to "sue for the forfeited penalty. This is in accord "with what was said in Thornton *v.* Schreiber 124 "U. S. 621, viz.: 'We, however, think that the "word "found" means that there must be a time "before the cause of action accrues at which they "are found in the possession of the defendant.' "That such expression was not necessary to the "decision of that case is asserted; but in view of "the fact that the Supreme Court, when discussing "Thornton *v.* Schreiber, in Bolles *v.* Outing Co., "*supra*, took no occasion to dissent from such con- "struction, and that no correction was made of "the statement, in the opinion of the Court below "then being reviewed, 'that the observation must "be regarded as the deliberate opinion of the "Court' (see Bolles *v.* Outing Co., 77 Fed. 968, 23 "C. C. A. 594), we are warranted in holding, as "the Court below did, that no right of action

"had accrued to the plaintiff when his action of "assumpsit was begun, and that such view is in "accord with the expressed views of the Supreme "Court of the United States."

Applying to the case at bar, the doctrine of election of remedies, we first realize that this doctrine holds only where the remedies are inconsistent with each other. Patterson *v.* Swan, 2 S. & R. 16, and Arnold *v.* Fitzgerald, 76 Penna. 385; and also that it is an invariable rule in Pennsylvania that several causes which are not of the same nature cannot be joined in a single action; and also that actions in form *ex contractu* and *ex delicto*, can never be joined. Noble *v.* Lalley, 50 Penna. 281.

In a State wherein there is no single action on which a seizure *in rem*, and *indebitatus assumpsit* for a money penalty—especially where the former must precede the latter, and is predicated thereon—how can it be said that the doctrine of election holds? And also how can it be said that these two remedies, of a radically different nature, can be joined in a single suit, if attempted, without doing violence to the invariable rule against it in Pennsylvania? The inevitable result would be a dismissal on demurrer.

Analogy Furnished by Admiralty Procedure.

Under such conditions may we not solve the problem by the analogy furnished by admiralty procedure? For example we have in the admiralty rules promulgated by this Court, the provision that in suits for pilotage, or mariner's wages, or supplies, or for damage by collision, "the libellant may proceed *in rem* against the ship * * * or against the owner * * * alone *in personam.*" While these rules have been construed to inhibit the joinder of such proceedings in a single action, (The Williamson, 108 U. S. 305) we find it stated

in Insurance Co. *v.* Alexander, 16 Fed. Rep. 279, that the rule which obtains in this country may be correctly stated to the effect that a prior suit pending is not a bar where the relief that may be given, or the remedies available, in the two suits, are different, though a stay may in a proper case be granted. See also the Normandie, 40 Fed. 591 and Watson *v.* Jones, 13 Wallace 715. Considering the 15th rule in admiralty, this Court in the "Williamson," 108 U. S. 305, speaking by Mr. Justice Blatchford said: "It excludes the joining in one suit, of the vessel and her owners; but it does not prevent the introduction into the libel of allegations as to the ownership of the vessel at the time of the collision, with a view to a proceeding to obtain such ultimate relief *in personam*, on the basis of a recovery *in rem*, as libellant may be entitled to."

The Finding and Seizure on Which This Action of Assumpsit for the Money Penalty was Predicated.

The fact that replevin was necessarily resorted to, for the finding and seizure of the offending copies, as a preliminary to the present action in assumpsit for the money penalty, was not the basis of any objection in the case at bar, in the trial court, nor was it interposed therein, in any form, as a defence, either as an election of remedies or otherwise. In Werckmeister *v.* Tobacco Co., 207 U. S. 284 (301) such an objection was made in the following words: "On the ground that replevin under the statutes of the State of New York is not an appropriate remedy or a lawful and legal remedy for taking possession of the alleged incriminating sheets or pictures"; but this objection was not made until after verdict, on a motion for new trial, and for that reason this Court held (1) that whether the "ordinary action for replevin under the New York Code" (employed in that case) was "the one

in the nature of replevin for the seizure of the plates and copies, indicated in the case of Bolles *v.* Outing Co., 175 U. S. 262, 266, we do not find it necessary to determine"; because (2) "examining this record, it is perfectly apparent that no objection was made to the form of the action until it was embodied after verdict, in the motion for new trial. * * * The record shows that the objection to the form of the remedy was first taken in any adequate way * * * when it was too late."

Summary of Conclusions.

But neither the facts in the case at bar as certified in the statement, nor the two questions certified, or either of them, present any such conditions as in the Werckmeister case. On the contrary it is manifest that the correct answer to the two questions submitted may properly depend:—

As to the first question certified: (a) upon the meaning of the word "forfeit", in the statute, in respect of the infringing copies; (b) upon whether the ruling, in the Werckmeister case, that the statute contemplates "a single action" to enforce both remedies, is an inflexible rule, to be construed strictly, notwithstanding that in Pennsylvania no such single action to enforce both remedies is possible under established law and procedure in that State; or (3) whether the "single action" referred to, in said decision, is to be interpreted as synonymous with "single judgment."

As to the second question certified: Whatever the correct answer to the first question may be, it is manifest that the second question may be correctly answered in the negative, without doing violence to, and indeed entirely consistent with, the actual meaning of the decision in the Werckmeister case (unless we are bound down to mere words), because a *writ* of seizure (call it a writ of replevin or what not) is not an "action" in the broad sense of that word (which implies a narr,

a plea, and an issue made thereby to determine the legality of the seizure), and certainly it is not a "judgment" (to support a plea or defence of former recovery); and even although the issuance of a writ of replevin is construed as the beginning of an action, in Pennsylvania, if the latter be not put at issue nor prosecuted to judgment, it is not an adjudication of anything, nor a proceeding or action in which the copyright proprietor, as plaintiff, "has exhausted his remedy in (a) the judgment", which latter is the language of this Court, last par., page 384 of the Werckmeister decision.

If it be, as it undoubtedly is, that no single action known to the law in Pennsylvania can afford these double remedies, then it necessarily follows either that the Statute R. S. 4965 is inoperative in that State to confer the whole or part of the benefits it confers on a copyright proprietor, or else that the term "single *action*", as used in the previous decisions, must be modified by construction to mean "single *judgment*"; and this would be in entire accord with the actual meaning and spirit of that decision as applied to this question passed upon in that case and also to the questions under consideration in the case at bar; and would also allow the use of the action or writ of replevin in Pennsylvania, for the purpose of "finding" and seizure, and if not prosecuted to judgment, would not bar a subsequent action of assumpsit for the money penalty based on such a previous "finding."

We respectfully submit that, for the reasons advanced herein, both questions certified should be answered in the negative.

Respectfully submitted,

BENNO LOEWY,
HECTOR T. FENTON,
Counsel for Hills & Co., Ltd.

February 28, 1911.

Supreme Court of the United States.

Hills & Company, Limited,

vs.

Joseph Hoover, et al.

October Term, 1910.

No. 101.

ON CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

BRIEF FOR JOSEPH HOOVER, et al.

ARGUMENT.

The plaintiff caused to be issued in the Circuit Court of the United States for the Eastern District of Pennsylvania a writ of replevin in accordance with the practice in Pennsylvania. The writ of replevin directed the Marshal to replevy or seize certain copies of described engravings, and also to summon the defendants to appear and answer the suit.

Under the Pennsylvania statute and practice regulating replevin suits, the Marshal is compelled to hold the goods seized for seventy-two hours, within which time the defendant has the right to give a claim property bond in which event the Marshal is compelled to return the goods seized to the defendant.

The plaintiff in the present case issued a writ of replevin to enforce its rights under the copyright law (R. S., Section

4965), for the forfeiture of the alleged infringing copies. The defendants gave no counter bond, so the alleged infringing pictures were delivered to plaintiff.

THE PLAINTIFF'S SUIT OF REPLEVIN IS STILL PENDING AND UNDETERMINED.

Under the Pennsylvania law as to replevin, the Act of Assembly directs that the plaintiff shall file a statement of claim, showing the plaintiff's title to which the defendant joins issue by filing an affidavit of defense. The cause is then at issue and may be ordered to trial.

See Section 66, Act of Assembly, 1901, Pennsylvania, P. L., page 88.

The plaintiff after beginning the suit in replevin brought an ordinary action of *assumpsit* in accordance with the Pennsylvania practice, and claimed therein to recover the pecuniary penalty of one dollar for alleged infringing copies, which it alleged had been seized in the replevin suit. The only plea permitted in Pennsylvania is *"Non Assumpsit,"* which was filed. The case was brought to trial, and at the trial the defendants objected to the introduction of the suit in replevin in evidence on the ground that it was not a proper remedy for the forfeiting of the pictures and defendants requested the trial court to direct a verdict in their favor, which was refused, and a verdict directed for plaintiff, the Court, however, reserving the question as to whether the plaintiff was entitled to recover. The defendants then filed a motion for judgment in their favor *non obstante veredicto,* which was granted and judgment was entered for defendants. From this judgment the plaintiff appealed.

The Court of Appeals, after argument, certified the following questions to the Supreme Court:—

1. In a Circuit Court of the United States within the State of Pennsylvania is the owner of a copyright for engravings restricted to a single action to find and seize the copies alleged to infringe, and likewise to recover the money penalty therefor?

2. In a Circuit Court of the United States within the State of Pennsylvania, does the institution by the owner of a copyright for engravings of an action of replevin for recovery of the copies alleged to infringe, not prosecuted to judgment, preclude such copyright owner from subsequently bringing and maintaining an action of *assumpsit* to recover the pecuniary penalty for the copies found and seized under the writ of replevin?

It will thus be seen from the foregoing history of this case, that the plaintiff in an attempt to enforce the forfeiture of the engravings, and the forfeiture of one dollar for each engraving under Section 4965 of the Copyright Law, has subjected the defendants to two actions, to-wit:—

First.—An action of replevin in which the plaintiff has actually recovered possession of the alleged infringing copies, although the action of replevin is still pending and undetermined.

Second.—An action of *assumpsit* based upon the action or replevin to recover the pecuniary penalty.

It may not be *inapropos* to state that the defendants have really been subjected to a third action for the same violation of plaintiff's copyright, as will be seen by reference to the case of Hills *vs.* Hoover, 136 Fed., 701, which is cited by plaintiff as authority that its copyright is valid and in which the plaintiff secured an injunction and recovered profits from the defendants.

UNDER SECTION 4965 A PLAINTIFF CANNOT SUBJECT A DEFENDANT TO TWO SEPARATE ACTIONS IN ORDER TO RECOVER THE MONEY FORFEITURE.

It is respectfully and earnestly submitted that a copyright owner for the purpose of enforcing the forfeiture of copies and the penalties provided by Section 4965, cannot subject a defendant to two separate and distinct actions. That section provides that the person offending—

> "Shall forfeit to the proprietor all the plates on which the same shall be copied and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale," &c.

It is respectfully submitted that where a person commits an act which subjects him to the penalties provided by this section, that the remedy of the copyright owner must be pursued in one action. The section does not contemplate that the defendant is to be subjected to more than one action. The policy of the law is against multiplicity of actions, whether against an offender or not. This policy is well settled, and is the basis for the law as to *res adjudicata*. A person whose rights are violated has his day in court; if he insists that he has more than one day in court, or entitled to more than one action, his authority for such position must be quite clear. The underlying principle of the doctrine of *res adjudicata* is that a person is entitled to one suit to test his rights, and not only is a judgment in an action final as to the question decided, but it is also final as to all questions that might have been decided.

It is, therefore, respectfully submitted, that Congress never intended by Section 4965 to give a copyright owner more than one action in which to pursue his remedies. If it had been intended that he should have the right to bring more than one action, it would have been an easy matter to have said so.

The section is a highly penal section imposing an extremely heavy penalty, and should be strictly construed. As it does not specifically authorize more than one action it is respectfully submitted that it must be interpreted as limiting the owner to one action, as it must be assumed that Congress did not intend an invasion of the well-recognized policy of the law which discourages multiplicity of suits.

That the bringing of two separate and distinct actions, one for the forfeiture of the offending pictures, and the other for the forfeiture of the money penalties, is not permis-

sible, is clearly and definitely settled by the decisions of the Supreme Court of the United States.

Werckmeister *vs.* American Tobacco Co., 207 U. S., 375;
Bolles *vs.* Outing Co., 175 U. S., 262.

The following cases are also to the same effect:—
Bolles *vs.* Outing Co., C. C. A. 77 Fed., 966;
Falk *vs.* Curtis Publishing Co., 120 Fed., 967.

In the case of Werckmeister *vs.* American Tobacco Co., *supra,* this subject is thoroughly discussed, and Section 4695 interpreted with great care by Mr. Justice Day, and he cites with approval the decision of Bolles *vs.* Outing Co., 77 Fed. Rep., 966, where Judge Wallace, for the Court of Appeals said:—

> "The statute is apparently framed to give the party whose copyright has been invaded complete relief by an action in which he can procure a condemnation of the infringing sheets, and at the same time recover, by way of compensation, a penalty for every sheet which he is entitled to condemn. The words 'found in his possession' aptly refer to a finding for the purposes of forfeiture and condemnation. The remedy by condemnation and forfeiture is only appropriate in a case where the property can be seized upon process; and where, as here, the forfeiture declared is against property of the 'offender,' it is only appropriate when it can be seized in his hands. *The section contemplates two remedies, enforceable in a single suit, each of which depends upon the same state of facts.* The aggrieved party may, at his election, pursue either one or both remedies. But it does not contemplate a recovery of penalties, except in respect to the sheets which can be condemned." (Italics ours.)

Mr. Justice Day also quotes from Bolles *vs.* Outing Co., 175 U. S., 262, the following language by Mr. Justice Brown:—

"No remedy is provided by the act, although by Section 4970 a bill in equity will lie for an injunction, but the provision for a forfeiture of the plates and of the copies *seems to contemplate an action in the nature of replevin for their seizure,* and in addition to the confiscation of the copies, for a recovery of one dollar for every copy so seized or found in the possession of the defendant." (Italics ours.)

After quoting this language, which is authority that a single action is the correct interpretation of the section, Mr. Justice Day says:—

"And in that case the view expressed by the Circuit Court of Appeals for the Second Circuit was approved (175 U. S., 268), and while the point was not necessarily involved, we think the indication in Bolles *vs.* The Outing Company, that a single action in the nature of replevin for the recovery of plates and copies and a penalty for copies found, is correct." * * * "As we have said, this section of the statute is highly penal (Bolles *vs.* The Outing Co., *supra*), *and there is nothing in its terms to indicate that the offender is to be subjected to more than one action;* on the contrary, the provisions of the section seem to point clearly to the conclusion that when the offender is brought into court, under this section, he shall forfeit to the proprietor the plates on which the articles shall be copied and every sheet thereof, whether copied or printed, 'and shall further forfeit one dollar for every sheet of the same found in his possession,' etc., and in case of a painting, etc., 'he shall forfeit ten dollars for every copy of the same in his possession, or by him sold or exposed for sale.'"

"There is nothing in this section which seems to contemplate the method of procedure pursued in this case, namely, a separate action for the money penalty, upon the theory that it arose only in case of actual

finding and judgment of condemnation, but the statute contemplates the bringing of the offender into court in one suit, in which the plates and sheets shall be seized and forfeited and the penalty recovered."

"If it had been the intention of Congress to provide two actions, one for the forfeiture of the plates, sheets, etc., and another for the recovery of the money penalty, it would have been easy to have said so." (Italics ours.)

The Supreme Court of the United States in the Werckmeister *vs.* American Tobacco Co. case, seems to have intended to put at rest all questions as to whether there should be one or two actions for the recovery of the forfeitures under Section 4965. The opinion of Mr. Justice Day is in unmistakable language, and clearly decides that a person who happens to offend against Section 4965 is not to be subjected to two actions for the recovery of the penalties therein provided.

The plaintiff in the present case, in its attempt to assert its rights under Section 4965, brought two actions. In the first it actually recovered the offending engravings, although no judgment of "forfeiture and condemnation" was ever entered in that action. The second action for the money penalty is based on the first one of replevin. It would be absolutely necessary, in order to permit the plaintiff to recover in the second action, to show that he brought the first one, and succeeded in securing the offending pictures. The second action is dependent upon the first one having been instituted, for without the replevin suit there would be no pretence of any engravings having been "found in the possession" of the defendants.

It is therefore respectfully submitted that in accordance with the decision of Werckmeister *vs.* American Tobacco Co., the plaintiff did not pursue the proper remedy for the recovery of the forfeitures under Section 4965.

THE PLAINTIFF'S ACTION IN ISSUING THE WRIT OF REPLEVIN IN PENNSYLVANIA TO ASSERT HIS RIGHTS UNDER SECTION 4965 WAS UNLAWFUL.

The plaintiff in this case issued the ordinary writ of replevin in accordance with the laws and practice of Pennsylvania. This action was taken in the face of the fact that there had been numerous decisions that a writ of replevin could not be issued as an appropriate remedy under Section 4965. In a replevin proceeding in Pennsylvania it is necessary that the plaintiff should at the time he issues his writ have title to the property replevied, together with the right to immediate possession.

That replevin in Pennsylvania is an inappropriate remedy for enforcing either of the forfeitures under Section 4965, has been decided in the following cases:—

Falk *vs.* Curtis Publishing Co., 102 Fed., 967;
Rheinhart *vs.* Smith, 121 Fed., 148;
Gustin *vs.* Record Publishing Co., 127 Fed., 603;
Hills *vs.* Hoover (The Present case) 142 Fed., 904, by Judge Holland.

In Falk *vs.* Publishing Co., *supra*, in discussing the propriety of the writ of replevin for this purpose, Judge McPherson, who examined the subject with great care, says:—

> "It is therefore clear that no penalty is recoverable except for such sheets of the infringing publication as may have been found in the defendant's possession for the purpose of forfeiture and condemnation. *Finding by means of a purchase, or by means of visual inspection is not enough. The finding must be in the course of a proceeding instituted for the express purpose of condemning and forfeiting the infringing articles.* What, then, is the appropriate course of proceeding for the purpose of enforcing the ferfeiture alone, or of collecting the penalty alone, or for the double purpose of enforcing the forfeiture and also of collect-

ing the penalty? *It seems to me to be clear that the action of replevin, as it is now known to the profession, cannot be used for either purpose or for both without laying violent hands upon it.* As it is now used—at least in the courts of Pennsylvania, to which I shall confine my attention—the claim property bond is an essential part of the proceeding. A plaintiff may use this form of action when he claims personal property in the possession of another, if the claimant has the right to possession. This contingency may present one objection to its use when the object is to forfeit, although the answer may be, as suggested by Judge Seaman in Morrison *vs.* Pettibone: 'That the term "forfeit," as used in the Statute, is not to be taken in its strict, ordinary sense; that the Act of Congress clearly intending to give to the proprietor an exclusive right of property in that which has been produced by his mind and skill, confers as well an ownership in all copies which are made by infringers; that through the act of piracy the title to the imitation vests in the proprietor of the copyright; in that sense only being forfeited, and, so regarded, replevin would lie to obtain possession.' However this may be, the right of the defendant to give a claim property bond and thus retain the property, with an indefeasible title thereto, must be wholly disregarded before the right to forfeit can be enforced. It would be useless to attempt to forfeit sheets and plates, if the defendant may give a bond for the value, and then become the undisputed owner. Moreover, the action of replevin in Pennsylvania has never been used to recover a separate, independent penalty, such as is given by this Act of Congress. *The only money recovery that is permitted is the value of the property, or damages for its detention, or both damages and value.*"

In Rheinhart *vs.* Smith, *supra*, Judge McPherson sustained a demurrer to a statement in replevin brought to

enforce a forfeiture under Section 4965. In that case he said:—

> "For reasons given in Falk *vs.* Curtis Publishing Co. (C. C.), 102 Fed. Rep., 967, I do not think that the common-law action of replevin as it is practiced in the State of Pennsylvania, is an appropriate remedy to enforce the forfeiture provided by Section 4965 of the Revised Statutes (U. S. Comp. St., 1901, page 3414) and the supplementary legislation relating to copyright. This is such an action in which the defendant has given a claim property bond and retained the offending articles; and these have thereby become, according to the Pennsylvania law, his indefeasible property. They cannot be forfeited now, even if such a result had ever been attainable in an action of replevin; and therefore, as it seems to me, the suit should be dismissed, because its only object cannot possibly be reached."

In Gustine *vs.* Record Publishing Co., *supra*, Judge McPherson again examines this question and decides, in a very carefully prepared opinion, that even under the new Act of 1901 in Pennsylvania relating to replevin, it is not a proper remedy for enforcing either the forfeiture or the recovery of penalties under Section 4965. In that opinion, after showing that the question has not been affected by the Act of 1901, he says:—

> "But there are other reasons why the Pennsylvania action of replevin is an inappropriate remedy. First, it is well settled in this State that replevin cannot be maintained without showing a general or special, an absoltue or a qualified property in the plaintiff at the beginning of the action, together with the right of immediate possession. Lake Shore Ry. Co. *vs.* Ellsley, 85 Pa., 258; Strong *vs.* Dunning, 175 Pa., 586. And this is the rule in other jurisdictions also. The plaintiff must show a general or special property in the goods replevied, and when the issue raised is

one of title, he must prove a title on which to base a lawful possession. 20 Amer. & Eng. Enc. of Law, 1054, and cases cited in the notes.

"Neither of these requirements is possessed by a plaintiff who is seeking to forfeit the defendants' property in an action of replevin under Section 4965. *When the action is brought the plaintiff has no title of any kind or degree to the property in question, he can only obtain title by a final judgment in his favor, and until then he has neither right of property nor right of possession.* If no claim property bond is given the right of possession is in the marshal, who holds the goods by virtue of his writ, while the question of forfeiture is being fought out. This is one fundamental difference between the Pennsylvania action of replevin and the remedy which is needed to make Section 4965 effective. I think the court is amply justified, therefore, in holding that the action of replevin in Pennsylvania is not suited to carry the load that is now sought to be imposed upon it. *The plaintiff who seeks to use it to vindicate the rights that are given him under Section 4965 finds that he cannot even lawfully issue the writ, for he has neither right of property nor right of possession. If he proceeds, however, and directs the writ to issue notwithstanding the law, and the practice, he cannot take possession of the goods, for the defendant may give bond (even since the Act of 1901) and retain the property until final judgment, with the powers of disposal during that period. Even if this further difficulty be surmounted by the defendant's failure to give the bond, the plaintiff is no better off, for he cannot obtain title to the goods which have never yet belonged to him, nor the right to possess them, until he obtains a judgment of forfeiture, and no such judgment has ever been known in this form of action. His right to the penalty is so intimately involved with his right to forfeit that no penalty can be recovered if no forfeiture can be entered,* to say nothing of the fact that judgment for a

> penalty is as much unknown in the action as a judgment of forfeiture. I am neither competent nor inclined to re-construct this well-known form of action by violating its long established rules."

It is interesting to note that in the case of Rhinehart *vs.* Smith, *supra*, counsel for the Appellant in the present case were upon the opposite side of the question, and in that case argued and secured from the Circuit Court for the Eastern District of Pennsylvania a decision opposite to the one they now contend for. In that case, it was held directly that the writ of replevin in Pennsylvania is not the proper remedy for enforcing the forfeitures for the infringing pictures under Section 4965, and the Appellant's counsel, who were counsel for the defendant in Rhinehart *vs.* Smith, demurred to the statement in that case upon the ground that the writ of replevin was not a proper remedy to enforce the forfeiture provided for in Section 4965, and Judge McPherson sustained that contention and held that the demurrer to the statement should be sustained.

It is also quite interesting to note that in the case of Falk *vs.* Curtis Publishing Co., counsel of record for the appellant in this case were counsel for the defendant there, and they argued that the law was as Judge McPherson declared it to be. In that case they argued as follows, as shown by the brief:—

> "*Second.*—It is, however, further contended that a writ of replevin is not a proper remedy in the State of Pennsylvania to enforce such a forfeiture, and that therefore the seizure by the marshal under such a writ did not constitute a finding for the purpose of 'condemnation and forfeiture' within the meaning of Section 4965 of the Revised Statute."

All of the authorities, therefore, including appellant's counsel, in cases prior to this case seem to clearly agree that there must be a proceeding for condemnation and forfeiture, and that replevin in Pennsylvania is not a proper remedy.

It is respectfully submitted that the foregoing authorities establish that the writ of replevin in Pennsylvania cannot lawfully be made use of for the purpose of enforcing forfeitures under Section 4965; the issuing of the writ by the plaintiff was contrary to law, and it is respectfully submitted that the plaintiff cannot make use of it as the basis for the second suit to recover money penalties. It would certainly be an unheard of proposition that the plaintiff could make an unlawful use of a writ the basis of a second proceeding.

The action of replevin begun in the present case is still pending and undetermined. According to the foregoing decisions it must be terminated in the action being dismissed and judgment entered for defendant. It is thus clear that there can be no forfeiture or condemnation in that proceeding.

IN THIS CASE THERE CAN BE NO FORFEITURE OF INFRINGING COPIES AND CONSEQUENTLY NO RECOVERY OF PENALTIES.

As we have seen in the previous discussion in the action of replevin in Pennsylvania, it is necessary that the plaintiff must have title to the articles replevined and the right to the immediate possession at the time he issues his writ. Under Section 4965, the infringing copies cannot be forfeited until they have been seized, and then only after judgment has been rendered in his favor. Consequently when the plaintiff in this case issued his writ he had no title to the engravings, and will only be able to obtain title by securing a judgment of forfeiture. Plaintiff adopted an improper remedy, and therefore whenever the replevin suit is tried judgment must be entered in favor of the defendants. It seems to be well settled that unless there can be a "forfeiture and condemnation" of the infringing copies that there can be no penalties recovered thereon. Thus in the case of American Tobacco Co. *vs.* Werkmeister, *supra*, Mr. Justice Day says:—

> "But the statute contemplates the bringing of the offender into court in one suit, in which the plates and

sheets shall be *seized and forfeited* and the penalty recovered." 207 U. S., 383.

In Falk *vs.* Curtis Publishing Company, 107 Federal Reporter, 126, the Circuit Court of Appeals for the Third Circuit said:—

> "In Bolles *vs.* Century Company, 175 U. S., 262, the Supreme Court expressly decided that the words 'found in his possession' aptly referred to a finding for the purposes of forfeiture and condemnation; and that the remedy by forfeiture and condemnation is only appropriate when the property can be seized upon process."

In that same case, the Circuit Court of Appeals said:—

> "If there was no forfeiture when the action began, it follows that there was no existing right to recover the fruit of the forfeiture, for an action is the prosecution of an existing right. *There must be finding before there is forfeiture; there must be forfeiture before the right accrues to sue for the forfeited penalty.*"

This case was cited by Mr. Justice Day in Werkmeister *vs.* American Tobacco Company, who referred to it in the following language:—

> "This language was held in Falk *vs.* Curtis Pub Co., 102 Federal Reporter, 967, 71, affirmed by the Circuit Court of Appeals for the Third Circuit in Falk *vs.* Curtis Publishing Company, 107 Fed. Rep., 126, to mean that before the action for the penalty would lie there must be a finding of the articles in the possession of the defendant by means of a proceeding instituted for the express purpose of condemnation and forfeiture, and that an action of *assumpsit* brought at the same time with the action of replevin was premature."

In the case of Gustin *vs.* Record Publishing Company, *supra*, Judge McPherson said, in discussing the action of replevin in Pennsylvania:—

> "Even if this further difficulty be surmounted by the defendant's failure to give the bond, the plaintiff is no better off, for he cannot obtain title to the goods which have never yet belonged to him, nor the right to possess them, until he obtains a judgment of forfeiture, and no such judgment has ever been known in this form of action. *His right to the penalty is so intimately involved with his right to forfeit that no penalty can be recovered if no forfeiture can be entered,* to say nothing of the fact that judgment for a penalty is as much unknown in the action as a judgment of forfeiture."

In the case of Bolles *vs.* Outing Company, 77 Federal Reporter, 965, which is also quoted by Mr. Justice Day in the Werckmeister case, the Circuit Court of Appeals by Judge Wallace, said:—

> "The words 'found in his possession' aptly refer to a finding for the purpose of forfeiture and condemnation. The remedy by condemnation and forfeiture is only appropriate in a case where the property can be seized upon process and where, as here, the forfeiture declared is against the property of the 'offender,' it is only appropriate when it can be seized in his hands. The section contemplates two remedies enforceable in a single suit, each of which depends upon the same state of facts, *but it does not contemplate a recovery of penalties, except in respect to the sheets which can be condemned.*"

In Bolles *vs.* Outing Company, when it reached the Supreme Court of the United States, 175 U. S., 266, the Supreme Court said:—

> "We concur with the learned judge who spoke for the Court of Appeals, that the words 'found in his possession' aptly refer to finding *for the purpose of forfeiture and condemnation.*"

In the case of Childs *vs.* New York Times, 110 Federal Reporter, 527, the Circuit Court held that unless there had been a legal forfeiture there could be no recovery of the penalty. In that case the plaintiff had found copies of papers containing the alleged infringement in the possession of the defendant, and had purchased them and then sued for the penalties for such copies. The court said:—

> "The case of Falk *vs.* Publishing Company (C. C. A.), 107 Federal, 126, seems conclusive upon the point at issue. The Circuit Court of Appeals there distinctly held that *unless there had been a legal forfeiture, the right to sue for the forfeited penalty has not accrued.*"

It thus seems to be clear that all the courts that have discussed the subject have all decided that under Section 4965, in order to recover the money penalties, there must have been a *forfeiture and condemnation* of the infringing copies. In the present case there has been no forfeiture of the alleged infringing copies to the plaintiff, as no judgment has been entered in the plaintiff's favor forfeiting and condemning the copies alleged to infringe. The suit of replevin is still pending and undetermined. But as the cases heretofore cited show that the plaintiff's action of replevin if ever brought to trial must result in a judgment for the defendant. The plaintiff cannot in the action of replevin ever secure a judgment of forfeiture of the alleged infringing copies. Could it be possible, therefore, that the plaintiff would be entitled to recover money penalties when he would not be entitled to recover the forfeiture of the infringing articles themselves?

It is respectfully submitted that Section 4965 contemplates the recovery of the pecuniary penalty only in those cases where the infringing copies can be seized and forfeited, and that if the forfeiture fails the penalty also fails.

AN OWNER OF A COPYRIGHT IS NOT WITHOUT A REMEDY IN PENNSYLVANIA.

The counsel for the plaintiff contended "that there is no form of single action or proceeding known to the law in Pennsylvania," to recover a forfeiture of copies and the money penalty. The plaintiff's counsel seemed to contend that there should be a different construction of Section 4965, when applied to Pennsylvania, because they insist that there is no remedy by single action in that State. It is, however, respectfully submitted that even if that was true the Section must receive a uniform construction, which applies to Pennsylvania, as to all other States in the Union. But the fact remains that the counsel for the plaintiff are saying too much when they say that there is no single action in Pennsylvania, which could be adopted as a remedy for the owner of a copyright to protect his interests under Section 4965.

In the case of Falk *vs.* Curtis Publishing Company, Judge McPherson, *supra*, for the Circuit Court of the United States for the Eastern District of Pennsylvania, suggests that the present action of trespass in Pennsylvania could be moulded so as to afford a proper remedy for the recovery of a forfeiture and penalties. In that case he said:—

> "But as the Act of Congress has given a special right of action which the injured party may use to enforce either or both of the punishments provided for infringement, it is probably not too much to say that it does not pass the wit of the bench and the bar to find a satisfactory method of procedure. It may well be that the actions on the case—now called 'trespass' in Pennsylvania—being an action *ex delicto*, and therefore appropriate to redress such a wrong as is done by an infringer, might be so moulded as to accomplish either or both purposes. The writ of summons, delivered to the Marshal, might be so framed as to contain a clause directing him to seize the offending articles, and thereafter the cause might proceed at the plaintiff's option, either to judgment or forfeiture alone, or for recovery

of the penalties alone, or to enforce both these punishments for the defendant's wrong doing."

The plaintiff instead of adopting the suggestion of the learned United States Judge issued the ordinary writ of replevin of Pennsylvania. Or the plaintiff might have adopted the suggestion in American Tobacco Company *vs.* Werckmeister, 146 Federal Reporter, 375, where the plaintiff issued a writ directed to the Marshal to seize certain pictures, in a proceeding to secure their condemnation and forfeiture. The pictures were seized by the Marshal and upon a hearing a judgment was entered that the pictures "are forfeited to the plaintiff." Counsel for the defendant, when the case reached the Circuit Court of Appeals, tried to argue that the proceeding was a replevin proceeding, but the Court of Appeals directly held that the proceeding was not a replevin proceeding under the New York code but was a direct proceeding to secure the condemnation and forfeiture of the goods, and that the writ was issued by the court under the broad power granted to it. The court say upon this subject:—

> "It is next contended that this action cannot be maintained because plaintiff did not have the right of property or possession before commencing the action. This is on the theory that the proceeding is an ordinary action of replevin under the New York code. It is, however, a direct proceeding to secure condemnation and forfeiture of the goods, as the complaint and judgment shows. It is an action 'in the nature of replevin for seizure of plates and copies,' which is referred to in Bolles *vs.* Outing Company, 175 U. S., 266, although the penalty for each copy seized already found in defendant's possession is not included in the same action as this court intimated that it might be. Bolles *vs.* Outing Company, 77th Fed., 966, 23 C. C. A., 594. The Marshal seized them, to await the judgment of the court, under a writ which is most analogous to a writ of replevin, but which the Circuit Court issues, not

solely under Section 914 (U. S. Comp. St., 1901, page 684), but under the broad grant of power in Section 716 (U. S. Comp. St., 1901, page 580.)"

This case was affirmed by the Supreme Court of the United States in American Tobacco Company *vs.* Werkmeister, 207 U. S., page 284, by Mr. Justice Day, who said that they were not called upon to decide whether the action was one of replevin under the New York code or whether it was an action in the nature of replevin for the seizure of the plates and copies indicated in the case of Bolles *vs.* Outing Company, 175 U. S., 286, as the question as to whether a proper remedy had been adopted had not been raised until after trial.

It will thus be seen that Judge McPherson, suggests that the proper remedy in Pennsylvania would be the action of trespass moulded to meet the requirements of the case. In the New York case, the Circuit Court of Appeals held that the court had the right to issue a writ to secure forfeiture and condemnation under the broad powers granted in Section 716. The plaintiff, instead of adopting either of these cases issued the ordinary writ of replevin in Pennsylvania, in which it is absolutely essential that he must have title at the time the writ issues or else the action must fail.

THE WORD "FORFEIT" IN SECTION 4965 MUST BE GIVEN ITS ORDINARY INTERPRETATION.

Counsel for the plaintiff have entered into a lengthy discussion as to the meaning of the word "forfeit" in Section 4965. They appear to contend that the meaning of the word "forfeit" is that there is a forfeiture of "the title," and not a forfeiture of the plates and copies and it is contended that if the word "forfeit" can be construed as meaning to forfeit "title" by the act of piracy, that then as soon as the act of piracy is committed the title is forfeited and consequently the title is in plaintiff, so as to sustain an action of replevin.

It is respectfully submitted that no such interpretation can be given to the term "forfeit. It will be noted that the language in Section 4965 is:—

> "He shall forfeit to the proprietor all the plates on which the same shall be copied and every sheet thereof, either copied or printed, &c."

According to the plain meaning of the same the offender is to forfeit the plates and "every sheet thereof, either copied or printed." Had Congress intended that by the act of piracy as soon as committed, the title to the plates and copies should become vested in the owner of the copyright, it would have been easy to have said so. On the contrary, however, those things which are forfeited are the plates and sheets themselves. The quotation from Judge Seaman in Morrison *vs.* Pettibone, cited by counsel for Hills & Co., is a mere dicta and shows that that learned judge instead of giving the term its ordinary meaning, admitted that he did not give it such meaning. The quotation begins as follows:—

> "The term 'forfeit' as used in the statute is not to be taken in its strict ordinary sense."

It is respectfully submitted that the learned judge in considering this penal statute was bound to construe the terms so as to give them their strict ordinary sense, and not to construe them so that they would operate more strongly against the defendants.

Thus in Bolles *vs.* Outing Company, 175 U. S., 263, Mr. Justice Brown said, as to Section 4965:—

> "The statute, then, being penal, must be construed with such strictness as to carefully safeguard the rights of the defendant and at the same time preserve the obvious intention of the Legislature. If the language be plain, it will be construed as it reads, and the words of the statute given their full meaning; if ambiguous, the court will lean more strongly in favor of the defendant than it would if the statute were remedial."

And if the contention of the plaintiff's counsel is correct, that immediately upon committing the piracy named under Section 4965, the defendant forfeited the title to the plates and copies and such title immediately became vested in the owner, then the owner would be entitled to recover the value of the property or damages for its detention even though he had parted with possession. This section has never been construed in that way and it is respectfuliy submitted that such contention would alter the rights of the defendant as required by the rules construing penal statutes.

The learned counsel for the plaintiff base their argument as to this meaning of the word "forfeit" by the declaration that Congress followed the British statute. Plaintiff's counsel apparently contend that the American copyright law is taken from the English copyright law. It will be seen, however, from an examination of the British statute quoted in Appellant's Brief, that the British Act specifically declares that the infringing copies *"shall be deemed to be the property of the proprietor of such copyright,"* and the proprietor shall be entitled *"to sue for and recover the same or damages for the retention thereof"* in an action of *detinue"* or "to sue for and recover damages for the conversion thereof in an action or trover."

It is respectfully submitted that if Congress had the British Statute before it at the time it enacted Section 4965 that that is the best evidence in the world that Congress never intended by the use of the word "forfeit" to mean that the title or property should be divested as stated in the British Statute. Instead of following the British statute which declares clearly that the infringing copies shall be "deemed to be the property of the proprietor" Congress was very careful to keep from the use of such words, but instead provided that the person offending should "forfeit" the plates and copies thereof.

It is therefore respectfully submitted that the word "forfeit" in Section 4965 must be given its ordinary interpretation.

FINAL SUMMARY.

It is respectfully submitted that the foregoing discussion establishes the following proposition:—

I. The plaintiff in the present action, contrary to the true meaning of Section 4965, brought two separate actions, one for the forfeiture of copies, and the second action based upon the first for the recovery of penalties.

II. Plaintiff in the present case has attempted to subject the defendant to two actions for the recovery of forfeiture and penalties, contrary to the meaning of Section 4965.

III. The Plaintiff adopted as a remedy for the forfeiture of infringing copies, the ordinary action of replevin in Pennsylvania, which action is not an appropriate action for that purpose and the plaintiff by issuing a writ of replevin for that purpose issued it contrary to law.

IV. In the action of replevin in Pennsylvania, the plaintiff must have title at the time he issues the writ. Under Section 4965, the owner of the copyright does not have title to the plates and copies until they have been seized and forfeited. Consequently the plaintiff could not succeed in securing a "forfeiture and condemnation" in the replevin suit.

V. The plaintiff's replevin suit is still pending and undetermined and if brought to trial must, under the law of replevin in Pennsylvania, result in a judgment for the defendants. There can, therefore, be no forfeiture of infringing copies in that action, and as there can be no "forfeiture and condemnation," of such alleged infringing copies there can be no penalties recovered thereon.

VI. The plaintiff's action for penalties is based and depends upon the action of replevin. The action of replevin having been unlawfully begun cannot be made the basis of the suit for penalties, as the suit for penalties must depend upon a legal seizure and forfeiture.

VII. A person cannot unlawfully issue a writ or issue a writ for an unlawful purpose and then make such a writ the basis of a second action. The plaintiff, therefore, by unlawfully issuing the writ of replevin cannot claim that the seizure therein was a lawful seizure.

VIII. The word "forfeit" in Section 4965 is to be considered in its ordinary sense and therefore cannot be held to mean the forfeiture of the title as distinguished from the forfeiture of the plates and copies.

It is therefore respectfully submitted that under the law and facts of this case the suit to recover pecuniary penalties cannot be maintained, and it is therefore finally submitted that both the questions certified should be answered in the affirmative.

Respectfully submitted,

WILLIAM A. CARR,
Counsel for Joseph Hoover, et al.